

REMARKS/ARGUMENTS

The Applicant has carefully reviewed in light of the November 17, 2004 Office Action, claims 1, 3-10, 12-16, 18 and 19 were finally rejected based upon the assertion that they are unpatentably over Yang (U.S. Pat No. 4,584,621) in view of a newly cited reference Mohtasham (U.S. Patent No. 6,483,049). In Light of the foregoing amendments and the following remarks, Applicant respectfully requests reconsideration and reexamination of the application.

35 USC § 103(a) CLAIM REJECTIONS

The present invention generally resides in a method for providing alternating current electric power to a power consuming device electrically connected to a switch assembly that is, in turn, electrically connected to first and second lines of a power source. The invention is designed such that a first line switch and a second line switch of the switch assembly are moved from open circuit positions to closed circuit positions in a non-simultaneous manner to complete the electrical circuit between the power consuming device and the source of power while avoiding harmful sparks. Furthermore, the first line switch is magnetically shielded from the second line switch, as recited in the independent claims. As recited in independent claim 1, the non-conductive shield between the first and second line switches for preventing the magnetic conduction of current is to prevent current drainage from the power source to the electrical circuit when the first and second line switches are in an opened circuit position. As recited in independent claim 10, in a particularly preferred embodiment, the first and second line switches are located in a compartment, including the magnetic induction shield so that magnetic induction of current is prevented between the first line switch portion and the second line switch portion.

As described in the application, a problem with electrical switches is that when they are turned on there is a possibility of the creation of a spark due to the simultaneous electrical connection of the positive and negative

connectors or plates. The non-simultaneous movement of the first and second line switches into their closed positions avoids such harmful sparks. The application further discusses that conventional switches on various electric-powered devices generate magnetization when one line is connected to a transformer or another part due to the induction of electric current. This results in consumption of electricity, but also reduces the useful life of electrical parts. The magnetic induction shield mentioned above and recited in the independent claims prevents such magnetic induction of currents between the switch portions or poles of the switch.

In the November 17, 2004 Office Action, the Examiner asserted that Yang discloses the instant claimed invention except for a shield between the first line switch and the second line switch in two line switch portions. Mohtasham is combined with Yang as it discloses a shield member (26) of non-conductive material disposed between the first line switch and the second line switch. The Examiner asserted that it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a shield member in Yang, as suggested in Mohtasham in order to provide a barrier between the first line switch and the second line switch. Applicant respectfully disagrees with this combination and assertion.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references when combined must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicant's disclosure. M.P.E.P. §2143 (citing In re Vaeck, 20 USPQ 2d 1438 (Fed.Cir. 1991).

Applicant respectfully asserts that the Yang and Mohtasham references have been improperly combined. Yang is concerned with a switch with two or more poles having unequal contact gaps and turn-off capacities. The result is that closing the multi-pole switch will sequentially open or close

the pairs of contact points, so as to limit arcing to only one pair of contact points.

Mohtasham is directed to a contact assembly having pairs of spaced apart fixed contact supported in an electrically insulating body with a set of movable contacts on a spring-loaded actuator. The uniqueness of the Mohtasham invention is that in contrast with contact assemblies in which the fixed contacts are U-shaped, Mohtasham provides L-shaped contacts to make it possible to accommodate more pairs of fixed contacts in a given volume (col. 2, Ins. 25-30). As discussed in the Mohtasham patent, the movable contacts are arranged such so that three of the switches are normally closed and one is normally open, that is the contacts extend from the moveable actuator outwardly into physical contact with the positive and negative legs of each switch until the actuator is moved and the fixed contacts come into electrical and physical contact with the legs of the switches which is normally open, thus immediately opening the other three switches.

Whereas Yang is directed to a general use switch, Mohtasham is directed to a contact assembly which is a type of alternative relay or adaptor/extensive panel for multiply connecting the electrical line. These switches are in no way related to one another in structure or purpose, and thus should not be combined as they are non-analogous to one another.

The mere fact that the references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. M.P.E.P. §2143.01 citing In re Mills, 16 USPQ 2d 1430 (Fed. Cir. 1990).

The teachings of Yang and Mohtasham are only analogous to one another given the teachings of the present application, otherwise, the references are completely non-analogous. Of course, it is axiomatic that a claimed invention is not obvious solely because it is composed of elements that are individually found in the prior art. Life Technologies, Inc. v. Clontech Laboratories, Inc., 56 USPQ 2d 1186 (Fed. Cir. 2000).

The Examiner picks and chooses aspects of the references in light of Applicant's claims in attempting to reconstruct Applicant's invention. The

Examiner's assertions are not supported by the references, but are impermissible hindsight based upon the teachings of Applicant's invention

"When prior art references require selective combination...to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself..."

Uniroyal Inc. vs. Rudkin-Wiley Corp. 5 USPQ 2d 1434, 1438 (Fed. Cir. 1988). It is impermissible to use the claims as a frame and the prior art references as a mosaic to piece together a facsimile of the claimed invention, and the Examiner must avoid the "insidious effect of a hindsight syndrome wherein only that which the inventor taught is used against the teacher". W.L. Gore & Assoc. v. Garlock, 721 F.2d 1540, 1552, 1553, 220 USPQ 303, 312, 313 (Fed. Cir. 1988).

The burden is on the Examiner to particularly identify the suggestion, teaching, or motivation in the reference(s) for their combination, and not just naming similarities between the reference(s) and the claimed invention. Ruiz v. A.B. Chance Co., 234 F.3d 654 (Fed. Cir. 2000), 57 USPQ 2d 1161, 1166; In re Dembiczak, 175 F.3d 994 (Fed. Cir. 1999), 50 USPQ 2d 1614, 1618.

"[A] rejection cannot be predicated on the mere identification ... of individual components of claimed limitations. Rather, particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed."

Ecolchem Inc. v. Southern California Edison, 56 USPQ 2d 1065, 1076 (Fed. Cir. 2000) quoting In re Rouffett, 149 Fed. 3d 1350, 1357 (Fed. Cir. 1998), 47 USPQ 2d 1453, 1456.

The Examiner's proposed combination would also alter the principle of operation of the Mohtasham reference. Yang discloses unequal contact gaps so that the pair of contact points are sequentially closed in an offset manner. In contrast, Mohtasham expressly illustrates and discloses that the first set of multiple contact points are simultaneously in contact with one another, and when the actuator is moved these contact points are simultaneously moved away so as to open these switches and simultaneously close the other contact points of the other switch which was previously opened.

As the MPEP states: "If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious." MPEP §2143.01 (citing In re Ratti, 123 USPQ 349 (C.C.P.A. 1959)); see also MPEP §2143.01 (citing In re Gordon, 221 USPQ 1125 (Fed. Cir. 1984)) ("If [the] proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." Incorporating the electrically insulating body of Mohtasham into Yang would embed the contacts and interfere with the physical connection to close the switch. Incorporating the offset contacts of Yang into Mohtasham would change the principle of operation of the Mohtasham device.

As described above, the present invention discloses a magnetic induction shield between the first and second line switches. Although Mohtasham discloses electrically isolating the conductive legs or contacts, there is no discussion whatsoever of magnetically shielding the contacts from one another.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. M.P.E.P. §2143.03 (citing In re Royka, 180 USPQ 580 (CCPA 1974)). All words in a claim must be considered in judging the patentability of that claim against the prior art. In re Wilson, 165 USPQ 494, 496 (CCPA 1970)). As the combination of Yang and Mohtasham fails to disclose all the claim limitations of the independent claims of the present application, the improper

combination also fails to establish the *prima facie* obviousness of the invention.

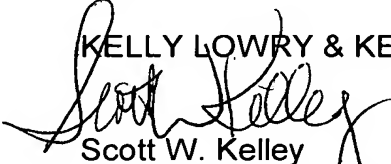
Furthermore, Neither Yang nor Mohtasham disclose the problem of magnetic induction of currents which wastes electricity and shortens the life of electronic components and circuitry. In fact, in Yang there is no discussion whatsoever of even electrically insulating the contact points from one another.

In the rare case where the prior art does not appreciate the existence of the problem solved by the invention, the applicant's recognition of the problem is, in itself, strong evidence of the non-obviousness of the invention. In re Nomiya et al., 184 USPQ 607, 612-613 (CCPA 1975).

CONCLUSION

Applicant, as noted above, respectfully asserts that the Yang and Mohtasham references are non-analogous to one another. Moreover, the references do not provide any suggestion or motivation to be combined with one another as suggested by the Examiner. Further, the Mohtasham reference would be changed in principle of operation where it could be combined with Yang, which does not disclose or suggest whatsoever any shield or compartments. Furthermore, the combination of Yang and Mohtasham fails to disclose a magnetic induction shield between the first and second line switches for preventing current drainage from the power source through the electrical circuit when the first and second line switches are in an open circuit position. Accordingly, Applicant respectfully asserts that the currently pending claims, 1, 3-10, 12-16, 18, and 19 are in condition for allowance, notice of which is hereby respectfully requested.

Respectfully submitted,


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